

### **REMARKS/ARGUMENTS**

This Amendment is filed in response to the Office Action dated July 1, 2008. In the Office Action: (1) Claims 46-53 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; (2) Claims 39-41 and 44-45 were rejected under 35 U.S.C. § 112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention; (3) Claims 33-35, 46-49, and 54-56 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 7,035,856 to Morimoto ("*Morimoto*"); (4) Claims 36-43, 52-53, and 57-60 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Morimoto* in view of U.S. Patent 5,774,885 to Delfer, III ("*Delfer*"); and (5) Claims 44 and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Morimoto* in view of *Delfer* in further view of U.S. Published Patent Application 2002/0077847 to Thiel ("*Thiel*") and U.S. Published Patent Application 2002/0032643 to Himmelstein ("*Himmelstein*"). For the Examiner's reference, Claims 1-32 and 61-71 were previously withdrawn, and Claims 33-60 remain currently pending in the application for further consideration.

#### **Claim Rejections under 35 U.S.C. § 101**

##### ***Rejection of Claims 46-53***

On Pages 2-3, Items 4-6 of the Office Action, the Examiner has rejected Claims 46-53 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner indicated that in order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus); or (2) transform underlying subject matter (such as an article or materials). More specifically, the Examiner indicated that while Claims 46-53 "*recite certain 'systems', they concretely identify neither the apparatus performing the recited steps nor any transformation of underlying materials.*" Applicant has amended Claims 46-53 to recite "*one or more processors ...*" to incorporate hardware components and identify the apparatus performing the recited steps. Support for this amendment is found on Page 29, Lines 18-21 of the specification as filed. Thus,

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Applicant respectfully requests the Examiner withdraw the current rejection under § 101 for these claims.

### **Claim Rejections under 35 U.S.C. § 112**

#### ***Rejection of Dependent Claims 39-41 and 44-45***

On Page 3, Items 6-9 of the Office Action, the Examiner has rejected Claims 39-41 and 44-45 under 35 U.S.C. § 112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. With respect to Claims 39-41, the Examiner has asserted that the scope of Claim 39 ***“is unclear because Claim 37, from which Claim 39 depends, requires that the tracking data is combined with the billing manifest,”*** and in Claim 39 the electronic billing manifest is compared with the tracking data, so ***“it appears that the system is configured to compare something with itself.”*** In addition, the Examiner has stated that Claims 40 and 41 inherit the above deficiency through dependency.

In response, Applicant has amended Claim 39, replacing ***“electronic billing manifest”*** with ***“package information data,”*** to make clear that the system is not configured to compare something with itself. Support for this amendment is found on Page 3, Lines 24-27 of the specification as filed. Based on the foregoing, Applicant respectfully requests that the Examiner withdraw the current § 112, Second Paragraph, rejection of these claims

In addition, the Examiner has rejected Claims 44-45 as being indefinite because the Examiner has asserted that Claim 44 recites ***“actions or steps as part of the system,”*** and Claim 45 inherits the deficiency of Claim 44 through dependency. In response, Applicant has amended Claim 44, to recite ***“debit”*** and ***“deposit”*** to make clear the system does not contain method steps. Accordingly, Applicant respectfully requests that the Examiner also withdraw the current § 112, Second Paragraph, rejection of these claims.

### **Claim Rejections under 35 U.S.C. § 102(e)**

In the Office Action, Claims 33-35, 46-49, and 54-56 were rejected under 35 U.S.C. § 102(e) as anticipated by *Morimoto*. See Office Action, page 4. For at least the following reasons, Applicant respectfully requests that the Examiner withdraw the current rejection of Claims 33-35, 46-49, and 54-56 under 35 U.S.C. § 102(e).

#### ***Rejection of Independent Claim 33***

Applicant respectfully asserts that *Morimoto* fails teach or suggest each and every limitation of independent Claim 33. In particular, independent Claim 33 has been amended to recite ***“an initial carrier computer system ... configured to determine whether the consignee address matches a rural destination classification or an urban destination classification; configured to instruct the initial carrier physical delivery system to deliver the package to the consignee address in response to the consignee address matching the urban destination classification; and configured to determine an intermediate location at which a subsequent one of the carriers is configured to receive the package in response to the consignee address matching the rural destination classification.”*** Support for this amendment is found on Page 13, Lines 11-13 of the specification as filed.

Applicant notes that *Morimoto* discloses a method and system for shipping items. When an individual wants to ship a package ***“a server is configured to send out requests for quotes to a number of regional shipping companies using a network. The server receives responses from the network and selects a route based on the responses ... the route may include shipping the item to one or more intermediate destinations before the item arrives at the final destination.”*** See Abstract. The result from the server is the ***“most efficient (e.g. lowest cost) routing for the package within the specified time constraints.”*** See Column 9, Lines 23-27. Thus, *Morimoto* selects the route for shipping the item based on the most efficient routing for the package (e.g., the lowest cost). *Morimoto* make no mention of using data indicating a ***“rural destination classification”*** or an ***“urban destination classification”*** as a criterion for

determining the shipping route of the item. As a result, *Morimoto* fails teach or suggest at least the recitation of Claim 33 discussed above. Accordingly, Applicant respectfully asserts that *Morimoto* does not anticipate independent Claim 33 and respectfully requests the Examiner to withdraw the current rejection of this claim.

#### ***Rejection of Independent Claim 46***

Applicant respectfully asserts that *Morimoto* does not teach or suggest each and every limitation of independent Claim 46. In particular, independent Claim 46 has been amended to recite, ***“determining whether the consignee address matches a rural destination classification or an urban destination classification; instructing the initial carrier delivery system to deliver the package to the consignee address in response to the consignee address matching the urban destination classification; and determining an intermediate location at which a subsequent one of the carriers is configured to receive the package in response to the consignee address matching the rural destination classification.”*** Support for this amendment is found on Page 13, Lines 11-13 of the specification as filed.

As discussed above, *Morimoto* simply does not use data indicating a ***“rural destination classification”*** or ***“urban destination classification”*** as a criterion for determining a shipping route for a package. Thus, *Morimoto* fails to teach or suggest at least this recitation of independent Claim 46. For at least the foregoing reasons, Applicant respectfully asserts that *Morimoto* does not anticipate independent Claim 46 and respectfully requests that the Examiner withdraw the current rejection of this claim.

#### ***Rejection of Independent Claim 54***

Applicant respectfully asserts that *Morimoto* does not teach or suggest each and every limitation of independent Claim 54. In particular, independent Claim 54 has been amended to recite, ***“a second executable portion for determining whether the consignee address matches a rural destination classification or an urban destination classification; a third executable portion for instructing an initial carrier physical delivery system to deliver one or the packages to the consignee address in response to the consignee address matching the urban destination classification; and a fourth executable portion for determining an intermediate location at***

*which a subsequent one of the carriers is configured to receive the package in response to the consignee address matching the rural destination classification.*" Support for this amendment is found on Page 13, Lines 11-13 of the specification as filed.

As discussed above, *Morimoto* simply does not disclose a processor that uses data indicating "*rural destination classification*" or "*urban destination classification*" as a criterion for determining a shipping route for a package. Thus, *Morimoto* fails to teach or suggest at least this recitation of independent Claim 54. For at least the foregoing reasons, Applicant respectfully asserts that *Morimoto* does not anticipate independent Claim 54 and respectfully requests that the Examiner withdraw the current rejection of this claim.

#### ***Rejection of Dependent Claims 34-35, 47-49, 55-56***

The Examiner has rejected dependent claims 34-35, 47-49, and 55-56 under 35 U.S.C. § 102(e) as being anticipated by *Morimoto*. Dependent Claims 34-35, 47-49, and 55-56 depend from independent Claims 33, 46, and 54, respectively, and therefore include all of the limitations of the independent claims plus additional limitations that further define the invention over the prior art. For example, dependent Claim 34 recites, "*wherein the initial carrier computer system is configured to communicate with a scanning device of the initial carrier physical delivery system to receive tracking data indicating detection of the initial carrier tracking number,*" which is further not taught or suggested by *Morimoto*.

Thus, for at least the reasons set forth above, Applicant respectfully submits that dependent Claims 34-35, 47-49, and 55-56 are patentable over *Morimoto* as such dependent claims depend from allowable base claims and include additional features that further distinguish the claims over *Morimoto*.

**Claim Rejections under 35 U.S.C. § 103(a)**

***Rejection of Dependent Claims 36-43, 50-53, and 57-60***

On Pages 8-12, Items 22-39 of the Office Action, the Examiner has rejected dependent Claims 36-43, 50-53, and 57-60 under 35 U.S.C. § 103(a) as being unpatentable over *Morimoto* in view of U.S. Patent 5,774,885 to Delfer (“*Delfer*”). Dependent Claims 36-43, 50-53, and 57-60 depend from independent Claims 33, 46, and 54, respectively, and therefore include all the limitations of these independent claims plus additional limitations that further define the invention over the prior art.

For example, Claim 40 recites, “*the initial carrier computer system ... is further configured to periodically compare the package information data to the compilation of package information data to confirm receipt of the package information data from the shipper computer system.*” The Examiner has asserted that this particular limitation is further taught by *Morimoto* in Column 13, Lines 9-15. However, Applicant respectfully disagrees.

Column 13, Lines 9-15 discuss that in the event multiple containers that have been shipped together take different routings to a final destination, an updated data file may be stored to a memory device on the container and/or carrier or conveyed to a central server and any party to the shipping transaction. This data file includes several pieces of information for the container such as a description of the goods being shipped in the container and any special shipping instructions for the container. See Column 9, Line 31 to Column 10, Line 8. However, *Morimoto* fails to teach or disclose periodically comparing package information data to a compilation of package information data to confirm receipt of the package information data. Furthermore, *Morimoto* makes no mention of conducting any type of comparison in this particular recitation at all. Thus, Applicant respectfully submits that Claim 40 is not taught or suggested by *Morimoto* or *Delfer*, whether considered alone or in combination.

Accordingly, Applicant respectfully submits that dependent Claims 36-43, 50-53, and 57-60 are patentable over *Morimoto* in view of *Delfer* as such dependent claims depend from allowable base Claims 33, 46, and 54 and include additional features that further distinguish the claims over *Morimoto* and *Delfer*.

***Rejection of Dependent Claims 44 and 45***

On Pages 12-13, Items 40-42 of the Office Action, the Examiner has rejected dependent Claims 44 and 45 under 35 U.S.C. § 103(a) as being unpatentable over *Morimoto* in view of *Delfer* in further view of U.S. Published Patent Application 2002/0077847 to Thiel ("*Thiel*") and U.S. Published Patent Application 2002/0032643 to Himmelstein ("*Himmelstein*"). In particular, the Examiner has asserted that, "*fi*lt would have been *prima facie* obvious to one having ordinary skill in the art at the time of the invention to incorporate the above teachings ... because this as well is merely a combination of old elements that would produce only predictable results." However, Applicant respectfully disagrees and traverses the combination because the Examiner has failed to establish a *prima facie* case of obviousness.

According to exemplary rationale (A) provided by the MPEP that may support a conclusion of obviousness based on old elements yielding predictable results, the Examiner must articulate the following: (1) a finding that the prior art included each element of the claimed invention; (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately; (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. See MPEP § 2143. However, the Examiner has failed to establish each of the elements detailed above. For instance:

**(1) *Morimoto, Delfer, Thiel, and Himmelstein Fail to Teach or Suggest Each Element of Claim 44 and 45***

Dependent Claims 44 and 45 depend from independent Claim 33 and therefore include all of the limitations of this independent claim plus additional limitations that further define the invention over the prior art. As discussed above in support of Claim 33, *Morimoto* fails to disclose or suggest "*an initial carrier computer system ... configured to determine whether the consignee address matches a rural destination classification or an urban destination*

*classification; configured to instruct the initial carrier physical delivery system to deliver the package to the consignee address in response to the consignee address matching the urban destination classification; and configured to determine an intermediate location at which a subsequent one of the carriers is configured to receive the package in response to the consignee address matching the rural destination classification,”* as recited in Claim 33. In addition, *Delfer, Thiel*, and *Himmelstein* fail to make up for the deficiencies of *Morimoto*. Thus, Applicant respectfully submits that *Morimoto, Delfer, Thiel*, and *Himmelstein* fail to teach or suggest each element of Claims 44 and 45.

**(2) One of Ordinary Skill in the Art Would Not Have Combined the Elements of Morimoto, Delfer, Thiel, and Himmelstein Because Himmelstein Is Non-Analogous Art**

Applicant respectfully submits that one of ordinary skill in the art would not have combined the elements of *Morimoto, Delfer, Thiel*, and *Himmelstein* because *Himmelstein* is non-analogous to Claims 44 and 45. As such, *Himmelstein* cannot properly be relied upon as a basis for rejection of Claims 44 and 45 under 35 U.S.C. § 103(a). MPEP § 2141.01(a).

In order to determine if a reference is analogous one of two criteria must be met: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Clay*, 966 F.2d 656, 658-659 (Fed. Cir. 1992).

To determine the appropriate field of endeavor, one must look to the explanations of the invention's subject matter in the patent application, including the embodiments, function, and structure of the claimed invention. *In re Bigio*, 381 F.3d 1320, 1326 (Fed. Cir. 2004). The present invention addresses the problem of facilitating the cooperation between multiples carriers (such as between a private carrier and the USPS) to take advantage of the strengths of each of the carriers. See Page 2, Line 29 to Page 3, Line 2 of the Specification. Thus, the present invention



is directed to systems for, and methods of, routing delivery of a package by a plurality of carriers.

*Himmelstein* is concerned with providing an electronic bartering system for bartering items or securities under agreed upon conditions. See Column 2, Lines 31-45. This allows a plurality of parties, each having one or more classes of items available for barter, to barter among themselves. See Abstract. Thus, the present application is concerned with the field of delivering packages via a plurality of carriers and *Himmelstein* is concerned with the unrelated field of bartering. Therefore, *Himmelstein* is not from the same field of endeavor.

With regard to whether a reference is reasonably pertinent, “a reference in a field different from that of applicant’s endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his or her invention as a whole.” MPEP § 2141.01(a) referring to *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007).

As explained in the MPEP, structural and functional differences are evidence of non-analogy or analogy. MPEP § 2141.01(a). In the instant case, any structural and functional similarities between *Himmelstein* and various embodiments of the claimed invention are far outweighed by structural and functional differences between *Himmelstein* and the various embodiments. In this regard, the only structural and functional similarity between the electronic bartering system of *Himmelstein* and the various embodiments of the claimed invention is that both make use of an escrow account. The manner (i.e., function) by which the electronic bartering system of *Himmelstein* and the various embodiments of the claimed invention operate are significantly different. As a result, *Himmelstein* would not have logically commended itself to the Applicant in considering the claimed invention as a whole and accordingly is not a reference that is reasonably pertinent.

**(3) One of Ordinary Skill in the Art Would Not Have Recognized that the Results of the Combination Were Predictable Because Thiel Teaches Away from the Claimed Invention**

One of ordinary skill in the art would not have recognized that the results of the combination of the elements of *Morimoto*, *Delfer*, *Thiel*, and *Himmelstein* were predictable. This is because *Thiel* teaches away from the claimed invention. To be considered prior art the “*prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention.*” See MPEP § 2141.02 VI.

The abstract of *Thiel* discloses, “[a] selection of a carrier is made from a number of available carriers according to at least one predetermined selection criterion. This selection can ensue before or after receipt of the shipping order by the intermediary. The intermediary relays the shipping order to the selected carrier.” *Emphasis added.* By selecting a carrier to ship orders to ensure receipt of the shipping order, *Thiel* leads away from the claimed invention which teaches under certain conditions using a “*plurality of carriers*” to ship packages.

Accordingly, Applicant respectfully submits for the above reasons that the Examiner’s rejection of Claims 44 and 45 as obvious in light of *Morimoto* in view of *Delfer* in further view of *Thiel* and *Himmelstein* is improper. Thus, Applicant respectfully requests the Examiner to withdraw the current rejection of dependent Claims 44 and 45.

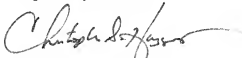
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Reply to Office Action of July 1, 2008

### CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action mailed July 1, 2008. The foregoing amendments to the claims, when taken in conjunction with the appended remarks, are believed to have placed the present application in condition for allowance, and such action is respectfully requested. The Examiner is encouraged to contact Applicant's undersigned attorney at (404) 881-7640 or e-mail at [chris.haggerty@alston.com](mailto:chris.haggerty@alston.com) to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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